UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,849	03/02/2000	Drew Bertagna	134/006	4129

35114   7590   05/26/2004

ALCATEL INTERNETWORKING, INC.
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EXAMINER
CHOUDHARY, ANITA

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 March 2004</u>.
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-38</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☒ Claim(s) <u>28 and 33</u> is/are allowed.
6)☒ Claim(s) <u>1-27 and 38</u> is/are rejected.
7)☒ Claim(s) <u>29-32 and 34-37</u> is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on <u>02 March 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-38 have been considered but are moot in
view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
subject matter which the applicant regards as his invention.

Claim 18, 28, and 33 rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

In referring to claim 18 lines 8-10 beginning with "for prioritizing", this limitation recites

prioritizing twice, first "depending on the value of the priority select indicator" and then "in

accordance with either the first priority or with one or more packet fields". It is suggested that "-

-- for prioritizing ---", line 8 be changed to "--- selecting for prioritizing ---" in order to clarify

and distinguish that the priority select indicator is used to *select,* not prioritize the packet.

In referring to claim 28, line 13-15 beginning with "prioritizing each"; similar to claim

18, this limitation recited prioritizing twice. It is suggested that "--- prioritizing ---", line 13 be

changed to "--- selectively prioritizing ---".

In referring to claim 33, line 10-12 beginning with "prioritizing each"; similar to claim 18

and 28, this limitation recited prioritizing twice. It is suggested that "--- prioritizing ---", line 10

be changed to "--- selectively prioritizing ---".

Claim Objections

Claim 17 and 33 are objected to because of the following informalities:

Claim 17 should depend on claim 14 and not claim 13, otherwise there is no anteceded

basis for "third value".

Claim 33, line 11, "--- prioritizes ---" should be changed to "--- prioritized ---"

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United
States before the invention thereof by the applicant for patent, or on an international application by another who
has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA

35 U.S.C. 102(e)).

Claims 1-11, 14-27, and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by

Ellington Jr. et al. (US 6,639,917).

In referring to claim 1, Ellington shows a system for converged service for interconnected

LAN's which supports any-to-any connections between Ethernet and Token Ring LAN's.

Ellington shows:

Receiving a plurality of packets (start, fig. 8) including respective first priorities (token

ring priorities, 814 or 802.1Q priority, 826) on a first port (34) (col. 7 lines 14-17);

Generating respective second priorities (802.1Q) as a function of the respective first

priorities (814, col. 7 lines 36-39);

Prioritizing selected ones (fig. 9 and 10, "DA support 802.1Q?", 914 and 1006 yes

branch) of the plurality of packets as functions of respective ones of the second priorities

(802.1Q) (col. 8 lines 31-33 and lines 52-62); and

Transmitting (912) the plurality of the packet including the respective second priorities

on a second port (36) (col. 8 lines 41-43).

In referring claim 2, Ellington shows, plurality of packets having respective source

addresses and the ones of the packets prioritized as a functions of respective ones of the second

priorities are selected as a function of respective source address (col. 7 lines 19-30).

In referring to claim 3, Ellington shows, plurality of packets have respective destination

address and the one of the packets not prioritized as a function of respective one of the second

priorities are prioritized as a function of respective one of the destination addresses (fig. 9, 10,

908, 1006, col. 8 lines 31-33 and 52-62).

In referring to claim 4, Ellington shows, respective first priorities are inbound 802.1Q tag

priorities (822).

In referring to claim 5, Ellington shows, respective second priorities are regenerated

802.1Q tag priorities (fig. 8, 812, 826).

In referring to claim 6, Ellington shows,

Receiving a packet with an included priority (fig. 9, 10: 906, 1004, TCI priority);

Determining a first priority (802.5 priority) for the packet based on included priority

(TCI) (see fig. 10, 1004);

Determining whether to mark the packet (determining whether destination supports

802.1Q priority, 914, 1006) (col. 8 lines 31-33).

Prioritizing the packet in accordance with the first priority (802.5) if the packet is marked

(wherein a packet is marked using 802.5 priority if it has a Token Ring destination, 908 yes

branch) (col. 8 lines 31-32).

In referring to claim 7, Ellington shows, prioritizing the packet or not in accordance with

a second priority (802.1Q) as a function of whether the packet is marked or not (1006-yes

branch).

In referring to claim 8, Ellington shows the first priority (802.5 priority) determination is

made as a function of a first value (TCI) in the packet and the marking determination is made as

a function of a second value (type field, 908) in the packet, wherein the first and second values

are different (col. 8 lines 31-33 and lines 52-54).

In referring to claim 9, Ellington shows first priority is instantiated in the packet upon transmission from the switch (col. 8 lines 52-54).

In referring to claim 10, Ellington shows mark, if any, is a single bit (1014, col. 63-65).

In referring to claim 11, Ellington shows, mark, if any, is removed from the packet prior to transmission from the switch (908 no branch, 802.5 field E-RIF is removed).

In referring to claim 14, Ellington shows second priority (802.1Q) is determined as a function of a third value (destination address 914 and 1006) in the packet, wherein the first and second and thirst values are different (col. 8 lines 32-35, 54-58).

In referring to claim 15, Ellington shows wherein the first value is a tag priority (802.5 tag priority, col. 7 lines 8-13).

In referring to claim 16, Ellington shows second value is a source address (col. 6 lines 45-54).

In referring to claim 17, Ellington shows third value is destination address ((destination address 914 and 1006) (col. 8 lines 32-35, 54-58).

In referring to claim 18, Ellington shows:

A first network interface (34) for receiving a packet with an included priority (T-R priority) from a first network (Token Ring network),

For determining a first priority (802.1Q) for the packet based on the included priority (T-R priority 814).

For marking the packet with a priority select indicator (802.1Q tag control information, TCI, col. 8 lines 21-24) and

For transmitting the packet (col. 5 lines 6-13).

A second network interface (36) coupled to the first network interface

For receiving the packet and prioritizing the packet depending on the value of the priority

select indicator (1004), wherein the packet is prioritized in accordance with packet field (802.5

packet priority) (col. 8 lines 52-54).

Transmitting the packet to a second network (col. 4 lines 56-65).

In referring to claim 19, Ellington shows wherein the second network interface is

operative for prioritizing the packet on not in accordance with a second priority (802.5) as a

function of whether the packet is marked or not (destination is token ring or not 906-908).

In referring to claim 20, Ellington shows wherein the first network interface (34) is

operative for determining the first priority (802.1Q) as a function of the included priority (T-R

priority, 814) in the packet and is operative for determining whether of not to mark the packet as

a function of a second value in the packet (802- source, whether the source is Token Ring),

wherein the included priority and second value are different.

In referring to claim 21, Ellington shows second network interface (36) operative for

determining a second priority (802.5 priority via step 910) as a function of a third value (908

destination) in the packet, wherein the included priority and the second value are different.

In referring to claim 22, Ellington shows mark, if any, is a single bit (1014, col. 63-65).

In referring to claim 23, Ellington shows, mark, if any, is removed from the packet prior

to transmission from the switch (918, 1008).

In referring to claim 24, Ellington shows, included priority tag is a tag priority (col. 7

lines 8-13).

In referring to claim 25, Ellington shows the second value is a source address (802-source, whether the source is Token Ring).

In referring to claim 26, Ellington shows third value is destination address (908 destination).

In referring to claim 27, Ellington shows:

Receiving on a first port a packet with a tagged priority (token ring priority);

Generating a first priority (802.1Q) as a function of the tagged priority (col. 7 lines 8-13);

Including the first priority in the packet (col. 8 lines 9-17),

Marking (creating token ring frame from CGS) the packet or not based on a first value (Destination type field 908) (col. 8 lines 31-33, lines 45-57).

Identifying a second priority (802.5) based on a second value (TCI) associated with the packet (1004); and

Determining whether to apply the first priority (802.1Q) or the second priority (802.5) based on whether the packet is marked or not.

In referring to claim 38, Ellington shows, step for replacing the first priorities (T-R priority) with the respective second priorities (802.1Q) of selected ones of the plurality of packets (814) prior to prioritizing selected ones of the plurality of packets (col. 7 lines 36-39, wherein token ring packets are prioritized with 802.1Q prior to sending to second interface).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ellington in view of Haddock et al. (US 6,104,700).

Although Ellington shows substantial features of the claimed invention, Ellington does

not show, applying the packet to a queue determined as a function of the first or second

priorities. Nonetheless this feature is well known in the art, and would have been an obvious

modification to the system disclosed by Ellington as evidenced by Haddock.

In an analogous art, Haddock shows a system for prioritizing packets according to QOS

queues as a function of the incoming packet property (traffic group) (col. 6 lines 1-9).

Given this feature, a person of ordinary skill in the art would have readily recognized the

desirability and advantages of modifying the system shown by Ellington to employ the feature

shown by Haddock, in order to manage and schedule high traffic loads and ensure a quality of

service guarantee (see Haddock, col. 2 lines 15-30).

Allowable Subject Matter

Claim 28 and 33 would be allowable if rewritten or amended to overcome the rejection(s)

under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 29-32 and 34-37 are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of the
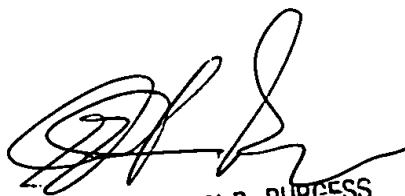
base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Anita Choudhary whose telephone number is (703) 305-5268.

The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC
May 19, 2004

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